Appl. No. 09/474,783
Response Dated May 25, 2004
Reply to Office Action of February 25, 2004

REMARKS

Claims 1-21 stand in this application. Claims 1, 7 and 19 have been amended to clarify patentable subject matter. Reconsideration and allowance of the standing claims are respectfully requested.

Claims 1-7 and 10-20 stand rejected under 35 U.S.C. 103(a) as being unpatentable over USPN 5,619,247 (Russo). Applicant respectfully requests reconsideration and removal of this rejection.

Claims 1-7 and 10-20, as amended, all recite the feature of "said embedded control information to define an action to be taken pertaining to the received broadcast content, said action to store said received broadcast content or reproduce said received broadcast content." At least this feature is not disclosed by Russo.

Claims 1-7 and 10-20 define over Russo since Russo fails to disclose "embedded control information." As correctly noted in the Office Action, Russo "fails to specifically state that this control information is embedded in the content." Office Action, Page 3. The Office Action also states an "Official Notice is given that it is well known and expected in the art to embed control information in broadcast content." Id. Applicant respectfully disagrees with the Official Notice. In previous submissions, Applicant has characterized "control information" as information to define an action to be taken, not how to take a particular action. Applicant has amended the claims several times in an attempt to clarify this feature. Consequently, Applicant submits that it is not well known and expected in the art to embed "control information" in broadcast content as recited in claims 1-7 and 10-20.

Claims 1-7 and 10-20 define over Russo since Russo fails to "define an action" as recited in the claimed subject matter. The Office Action found Applicant's previous arguments unpersuasive since "specifying how to do something and defining an action (which is doing something), is the same." Office Action, Page 2. Applicant believes there may be a misunderstanding. Specifying how to do something means to provide instructions that may be used to accomplish a particular result, such as providing instructions on how to decode a compressed or encrypted file. Defining an action, as recited in the claimed subject matter, means to provide information as to whether the instructions can be used to accomplish the particular result. In other words, defining an action is similar to identifying whether to use the instructions.

Claims 1-7 and 10-20 define over Russo since Russo fails to "define an action to be taken pertaining to the received broadcast content, said action to store said received broadcast content or reproduce said received broadcast content" as recited in the claimed subject matter. Russo provides supplemental information, to include future schedule memory, authorization keys, and compression algorithms. Russo, Col. 8: Lines 55-65. Future schedule memory is clearly not related to an action to store or reproduce received broadcast content. According to the Office Action, "the authorization key and compression algorithms directly define actions or operations to be taken pertaining the broadcast data." Office Action, Page 3. A compression algorithm provides instructions on how to compress or decompress a block of information. It does not provide information as to whether the compression algorithm should be used on to store or reproduce received broadcast content. The term "authorization key" is not defined by Russo. Applicant submits that the ordinary meaning of "authorization key" is a code to

unlock encrypted or protected software. In any event, the authorization key does not define whether the authorization key should be used to store or reproduce received broadcast data.

In addition, the Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness. According to the MPEP, three basic criteria must be met to establish a *prima facie* case of obviousness. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP 706.02(j).

The Office Action has failed to meet its burden of establishing a *prima facie* case of obviousness since Russo fails to teach or suggest all the claim limitations. The Office Action provides Official Notice that it is well known and expected in the art to embed control information in broadcast content. Applicant respectfully disagrees as previously discussed. Moreover, Applicant submits that this feature is disclosed by the instant application, and it is being applied in hindsight to Russo. Since all the features of claims 1-7 and 10-20 are not disclosed by the cited reference, the Office Action has failed to meet the burden of establishing a *prima facie* case of obviousness, and therefore the obviousness rejection is overcome.

For at least the reasons given above, Applicant submits that claims 1-7 and 10-20 represent patentable subject matter. Removal of the rejection for claims 1-7 and 10-20 is therefore respectfully requested.

Claims 9 and 21 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Russo. Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Russo in further view of USPN 4,945,563 (Horton). Claims 8, 9 and 21 all recite the same features discussed above with reference to claims 1-7 and 10-20. Applicant submits that claims 8, 9 and 21 represent patentable subject matter for at least the same reasons given for claims 1-7 and 10-20.

For at least the above reasons, Applicant submits that claims 1-21 recite novel features not shown by the cited references. Further, Applicant submits that the above-recited novel features provide new and unexpected results not recognized by the cited references. Accordingly, Applicant submits that the claims are not anticipated nor rendered obvious in view of the cited references.

It is believed that claims 1-21 are in allowable form. Accordingly, a timely Notice of Allowance to this effect is earnestly solicited.

The Examiner is invited to contact the undersigned at 724-933-3387 to discuss any matter concerning this application.

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The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. § 1.16 or § 1.17 to Deposit Account No. 02-2666.

Respectfully submitted,

BLAKELY, SOKOLOFF, TAYLOR & ZAFMAN LLP

John F. Kacvinsky, Reg. No. 40,040
Under 37 CFR 1.34(a)

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12400 Wilshire Blvd., 7th Floor
Los Angeles, California 90025